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| APPLICATION NO.               | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|---------------------|------------------|
| 10/782,006                    | 02/19/2004  | Eick Niemeyer        | 414-35587-USCP      | 4322             |
| 44871                         | 7590        | 12/15/2005           | EXAMINER            |                  |
| MADAN, MOSSMAN & SRIRAM, P.C. |             |                      | FITZGERALD, JOHN P  |                  |
| 2603 AUGUSTA                  |             |                      | ART UNIT            |                  |
| SUITE 700                     |             |                      | PAPER NUMBER        |                  |
| HOUSTON, TX 77057             |             |                      | 2856                |                  |

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                |                                 |  |
|------------------------------|--------------------------------|---------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/782,006  | Applicant(s)<br>NIEMEYER ET AL. |  |
|                              | Examiner<br>John P. Fitzgerald | Art Unit<br>2856                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8,10,11,16-20,23,25,26,31-35,40 and 41 is/are rejected.
- 7) ☒ Claim(s) 2, 6, 7, 9, 12-14, 21, 22, 24, 27-30, 36-39 and 42-45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/19/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10, 25 and 40 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the claims recite the limitation "the tool draw rate" in their last lines respectively. It is unclear as to which "rate" the "tool draw rate" is referring. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

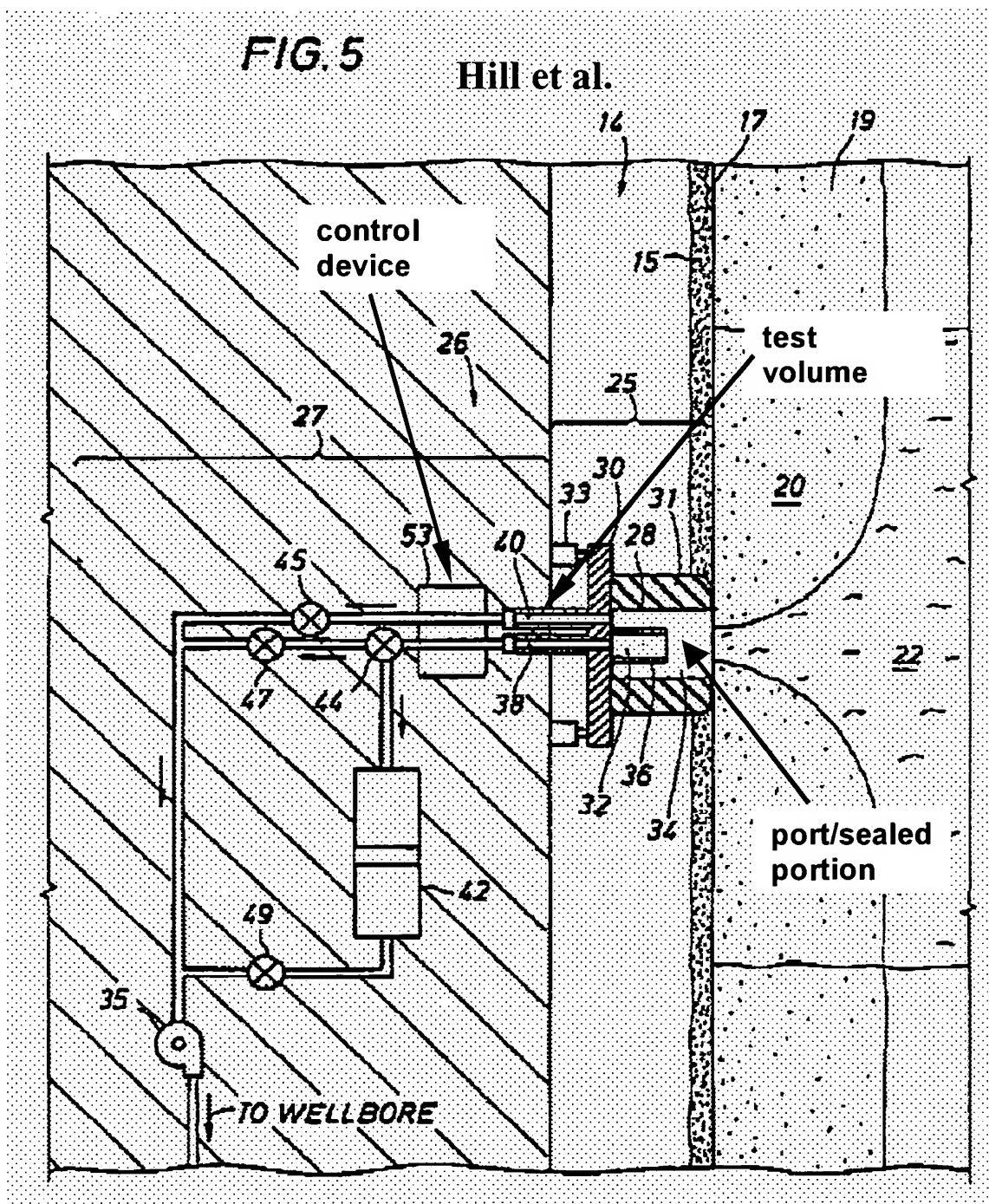
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. § 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 3-5, 8, 11, 16-20, 23, 26, 31-35 and 41 are rejected under 35 U.S.C. § 102(e) as being anticipated by US 6,964,301 to Hill et al. Hill et al. disclose a method and apparatus for determining in situ a desired formation parameter of interest (see Fig. 5 below) including all of the recited elements of the claims of a any conveyable tool into a well borehole (as recited in claims 17 and 32) (Hill et al.: col. 6, lines 7-20); a test unit (27) in the tool with a probe/port in fluid communication with the formation via packers or seals (as recited in claims 3, 4, 18, 19, 33 and 34) including a test volume (38, 40), a control/sensing device (53) for monitoring/determining at least one characteristic of the test volume (i.e. formation fluid parameters, e.g. contamination/composition, pressure, temperature (as recited in claims 11, 26 and 41) (Hill et al.: col. 11, lines 6-13); wherein the draw rate of the fluid into the test volume is controlled by the control device, capable of adjusting/altering the draw rate based on a measured/determined formation fluid characteristic (note, that includes increasing or decreasing during one or more of a first or second draw portion, as recited in claims 1, 8, 16, 23, and 38)(Hill et al.: col. 9, lines 1-53); the control device includes a variable rate pump (35) (as recited in claims 20 and 35); and a processor and controller following programmed instructions for control of the apparatus (as recited in claim 31) (note: a processor and programmed instructions are inherent features of any measurement device to measure/process and subsequently perform controlled operations based on the measured data/values/output, as disclosed by Hill et al.).



***Allowable Subject Matter***

5. Claims 2, 6, 7, 9, 12-14, 21, 22, 24, 27-30, 36-39 and 42-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 10, 25 and 40 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is invited to review Prior Art cited by the Examiner on PTO form 892 accompanying this Office Action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Fitzgerald whose telephone number is (571) 272-2843. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams, can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

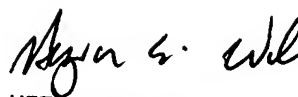
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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JF

12/05/2005



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